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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,129	01/16/2004	Peter S. Brown	ENDOV-63893	7202
24201 7590 12/22/2006 FULWIDER PATTON 6060 CENTER DRIVE 10TH FLOOR LOS ANGELES, CA 90045			EXAMINER MILLER, CHERYL L	
			ART UNIT 3738	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/760,129

Applicant(s)

BROWN ET AL.

Examiner

Cheryl Miller

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/13/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7-33 is/are pending in the application.
- 4a) Of the above claim(s) 9-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,8 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachments 1-3

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4, 7, and 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although a graft having an H-shape is disclosed and shown in figure 8, this shape is seemingly prior to placement in the catheter, and prior to covering the sensor. Therefore, the H-shape is considered new matter since there is no support for having the H shape prior to and following folding portions of the graft over the sensor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 7, 8, and 28-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the graft" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change the above to recite, --attaching a sensor to a graft; attaching a marker to the graft;--. Claims 2, 4, 7, 8, and 28-33 depend upon claim 1 and inherit all problems with the claim.

Claim 8 is indefinite. It is suggested to change, "comprising a single folded section" to recite, --comprising placing a single folded section--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 7, 8, 28-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolinsky et al. (US 6,840,956 B1, cited previously). Wolinsky discloses a method of protecting a sensor attached to a graft (col.5, lines 38-45) comprising attaching a sensor (12) to a graft (14), attaching a marker to a graft (Wolinsky discloses use of markers on the implant, col.6, lines 13-16; disclosed but however not shown, see Quiachon et al. US 5,749,920 fig.23 as evidence as to how markers are placed on a graft in the art) folding portions of the graft to cover the sensor (see either fig.3A or 3B) and the marker (inherently the markers will be covered, since they are present on the graft surface and as the entire graft is seen folded over itself, inherently it will cover the markers, wherever they are on the graft, see fig.3a) and placing the graft (14) within a catheter (32).

Wolinsky discloses a single or multi folded section of graft material covering the sensor (figs.3A, 3B; attachment 1) or four layers of folds cover the sensor (attachment 1). Wolinsky discloses configuring the sensor such that it is perpendicular to a radius of the graft (see attachment 2). Wolinsky discloses configuring the graft to an H-shape (fig.3A may be considered an H-shape as it is similar to the configuration shown by applicant's own figures; see attachment 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In the alternative to the above rejections, claims 1, 2, 4, 7, 8, and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinsky et al. (US 6,840,956 B1, cited previously) in view of Quiachon et al. (US 5,749,920). Wolinsky discloses a method of protecting a sensor attached to a graft (col.5, lines 38-45) comprising attaching a sensor (12) to a graft (14), folding portions of the graft to cover the sensor (see either fig.3A or 3B) and placing the graft (14) within a catheter (32). Wolinsky discloses the use of markers (col.6, lines 13-16), however is silent to mention the specific placement of the markers. Quiachon teaches in the same field of vascular grafts, placement of a plurality of markers (197; fig.23) along the length of the graft (55) such that the graft may be detected during deployment (col.14, lines 18-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to

combine Wolinsky's graft having a use of radiopaque markers, with Quiachon's teaching of exact placement of the markers directly onto the graft surface such that the graft may be detected during delivery. Inherently Wolinsky's graft will fold over the markers as well as the sensor, since the entire graft is folded upon itself.

Wolinsky discloses a single or multi folded section of graft material covering the sensor (figs.3A, 3B; attachment 1) or four layers of folds cover the sensor (attachment 1). Wolinsky discloses configuring the sensor such that it is perpendicular to a radius of the graft (see attachment 2). Wolinsky discloses configuring the graft to an H-shape (fig.3A may be considered an H-shape as it is similar to the configuration shown by applicant's own figures; see attachment 3).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cheryl Miller


BRUCE SNOW
PRIMARY EXAMINER

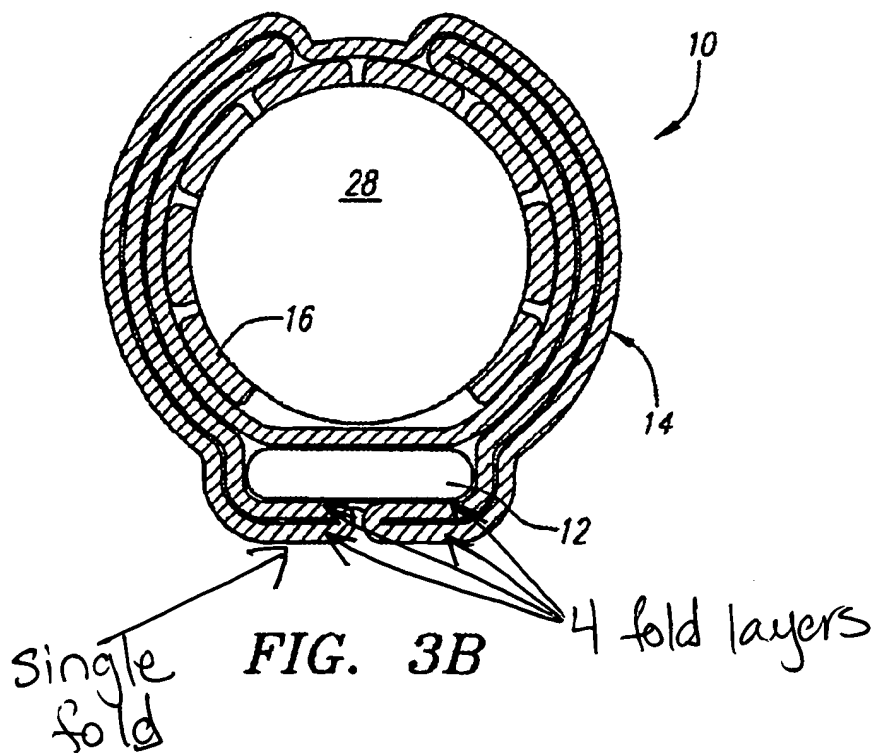
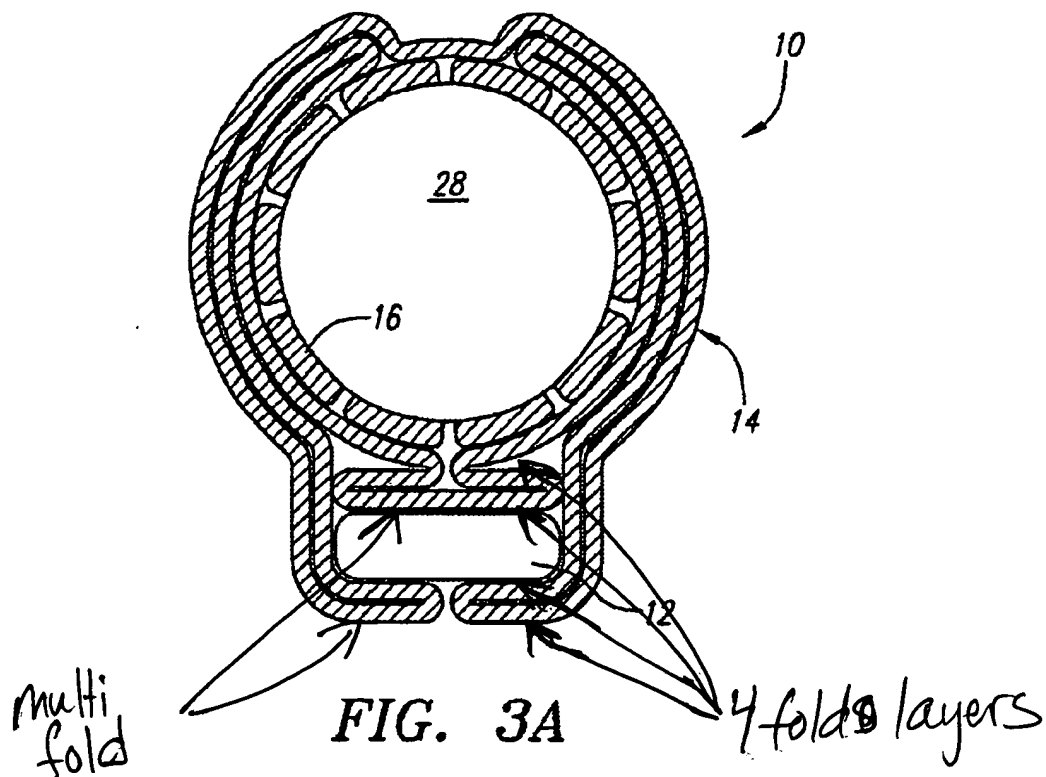
Attachment #1 (marked up)

U.S. Patent

Jan. 11, 2005

Sheet 2 of 5

US 6,840,956 B1



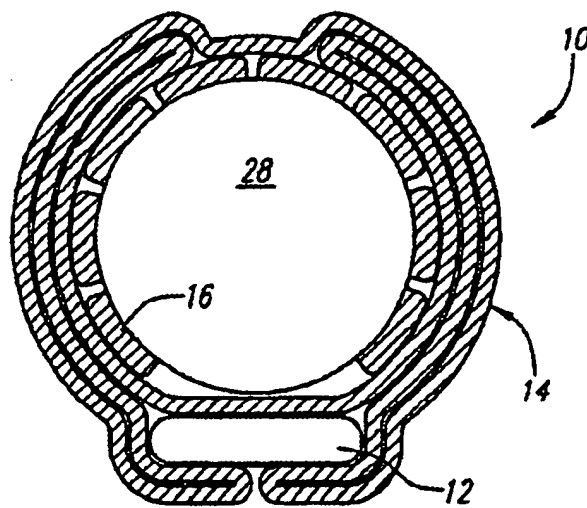
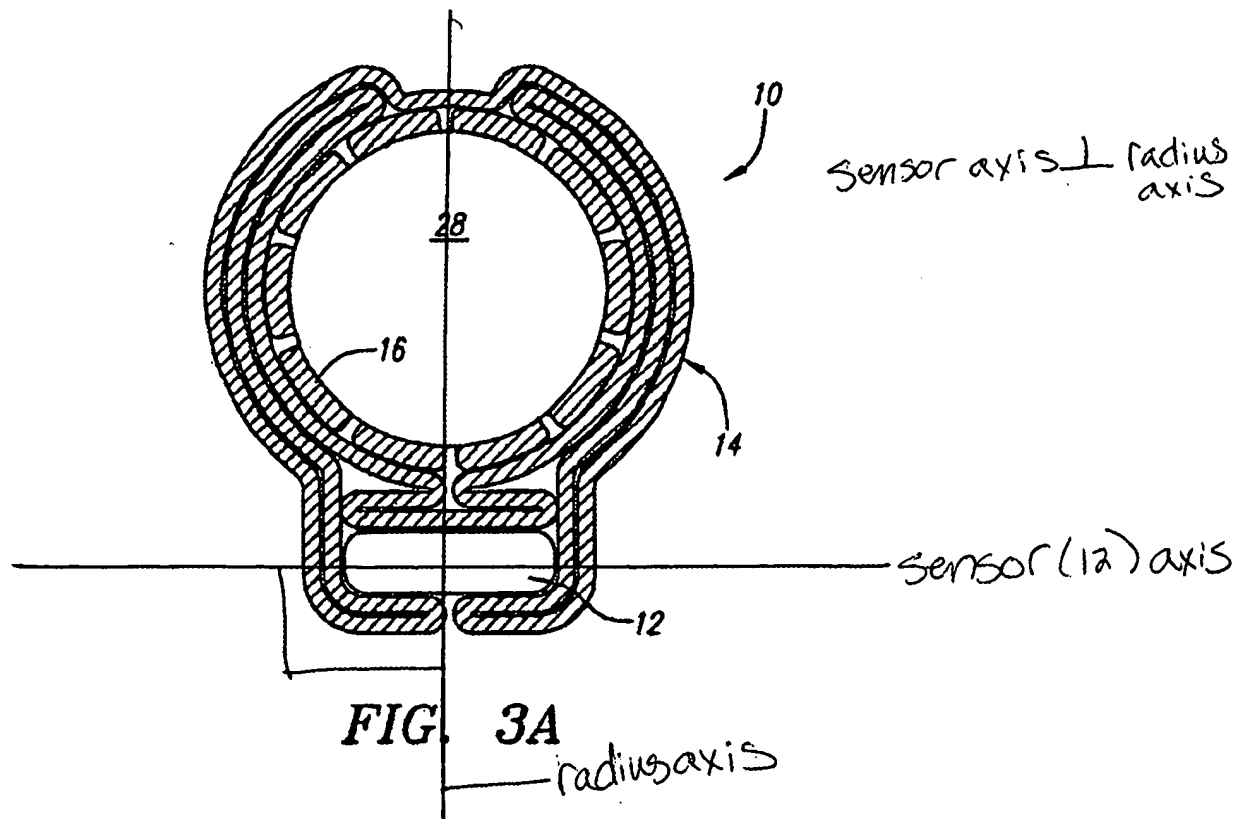
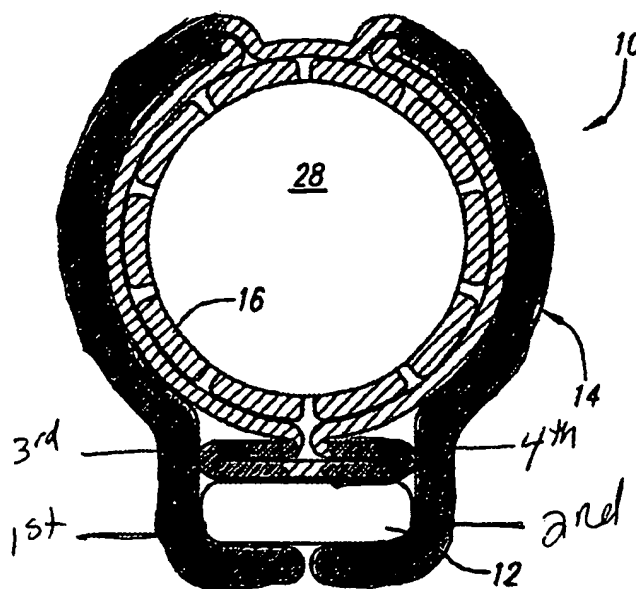


FIG. 3B



★ 4 legs of
"H" seen
shaded in red
separately

FIG. 3A

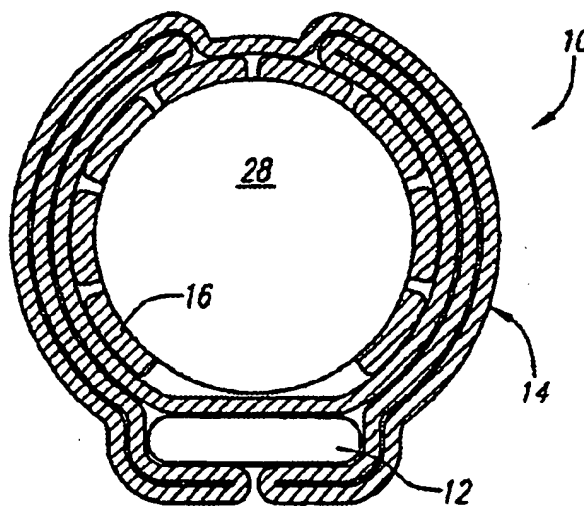


FIG. 3B